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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/786,240

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Richard C. Holz

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2692

7590

06/09/2006

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EXAMINER

CHU, YONG LIANG

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,240

Applicant(s)

HOLZ ET AL.

Examiner

Yong Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-25 is/are pending in the application.
4a) Of the above claim(s) 7, 13 and 19-25 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 3-6, 8-12, and 14-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

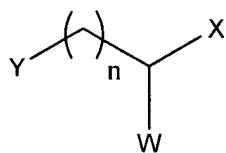
- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Amendment on Claims 1, and 8 are **not entered** because new matter is introduced. Claim 2 is cancelled by amendment filed on 4 May 2006. Claims 5-6, 11-12, 14, 17-18 are amended by amendment filed on 4 May 2006. Claims 7, 13, and 19-25 stand withdrawn. Therefore, claims 1, 3-25 are pending in the instant application. Claims 1, 3-6, 8-12, and 14-18 are currently examined.

Response to Amendments

Applicant's Amendment on claims 1, and 8 dated on 4 May 2006 has been denied to enter because new matter is introduced. The new matter is the new formula



, wherein W is H; Y is COOH; and X is PO₃H₂. There is no support from the Specification to support the amendment. The rest amendment has been entered.

Response to Arguments

A. Rejections Under 35 U.S.C. §103

The Arguments of rejection over claims 1-6 under 35 U.S.C. §103 on page 12-14 of the Response is not persuasive. Actually, the Office has established *prima facie*

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case of obviousness by listing the compound by *Keller*, which reads on the instant claims except one functional group -COOH different from $\text{-CH}_2\text{OH}$. However, as indicated in the previous Office Action, *McMurry* teach **a basic type** of organic reaction which can convert -COOH into $\text{-CH}_2\text{OH}$ by using LiAlH_4 with a reasonable success. One skilled in the art to which it pertains knows carboxylic acid including the compound by *Keller* can be converted to corresponding alcohol with reasonable chance to succeed. The suggestion comes from *McMurry* reference. Therefore, the comment ".teaches a specific chemical compound with a reference (McMurry) teaching a specific conversion reaction could only be made after reviewing the Applicant's disclosure and using hindsight." is not persuasive. It is worth to point out that the instant product claims are about novel, non-obvious and useful compounds and compositions, and the Office does not weigh the disclosure of a compound for its intend to use. Therefore, the rejection over claims 1-6 under 35 U.S.C. §103 retains.

The Examiner is aware that there is an error by Applicants on line 3 page 12 of the Remarks, where the 103 rejection should be over claims 1-6 as stated in the previous Office Action not claims 7-11, and 14-15.

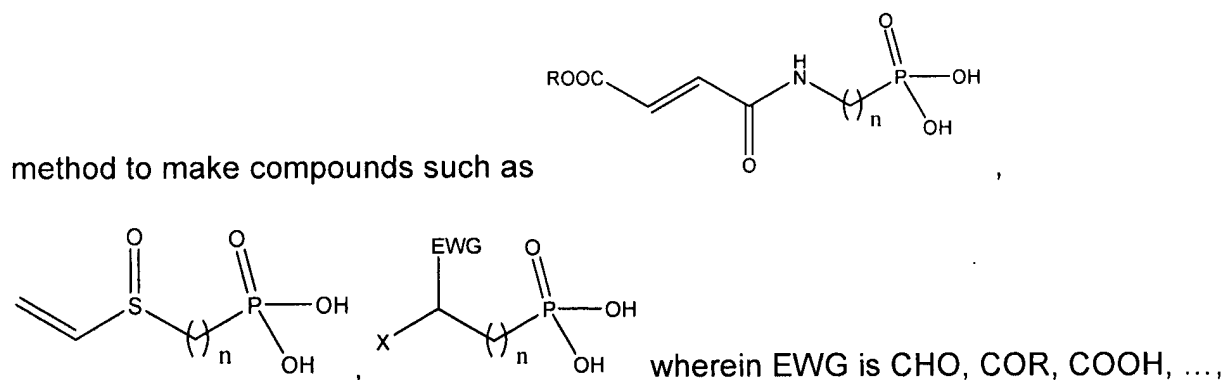
B. Rejections Under 35 U.S.C. §112: Written Description Requirement

The Arguments of rejection over claims 1-2, and 5-6 under 35 U.S.C. §112 Written Description Requirement is not persuasive, because the Specification does not support Claims 1-2, and 5-6. However, since Claims 1, and 5-6 have been amended, and Claim 2 has been cancelled, it required a new round of examination on these claims. Since the amendment of Claim 1 is not entered due to new matter, rejection

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over Claim 1 is retained. The Example 9 at paragraph [0091] teaches a method to make 4-iodobutylphosphonic acid (2), which does not support the compounds in the **original Claim 1**. Therefore, the rejection Under 35 U.S.C. §112 is appropriate. The Office would like to remind Applicants that Example 9 compound 4-iodobutylphosphonic acid as in the amended Claim 1 is not patentable over a patent application DE 1023647 (1958), even though such an amendment has been denied.

With respect to Claims 8-9, 11-12, 14-15, and 17-18, Applicant's argument on line 9 page 16 of Remarks "...4-iodobutylphosphonic acid...are not so different from the claimed chemical formulas, and one of ordinary skill in the art would be capable of making the class of compounds with the chemical formulas depicted in the specification and Example 9 in hand" is not persuasive. Example 9 paragraph [91] teaches a hydrolysis method of making 4-iodobutylphosphonic acid by hydroiodic acid catalyzed hydrolysis of 4-bromobutylphosphonic acid. However, the working example can not apply to a



and X is halogen, in Claims 8-9, and 14-15. Extra written description and disclosure are needed. Therefore, rejection over Claims 1-2, 5-6 8-9, 11-12, 14-15, and 17-18 are retained.

C. Rejections Under 35 U.S.C. §112: Enablement Requirement

The Arguments of rejection over Claims 3-4, 10, and 16 under 35 U.S.C. §112 Enablement Requirement is not persuasive. The working Example 9 at paragraph [0091] teaching a method to make 4-iodobutylphosphonic acid does not enable one skilled in the art to which it pertains to make the invention in claims 3,4,10 and 16, because they are compounds or compositions comprising different compounds with different structures. The “how to make” requires a disclosure not only of the reaction conditions required to produce all the embodiments of invention as claimed generically but also how to obtain the starting materials employed to do so, without ***undue experimentation or the exercise of inventive skill to do so***. Problems of sufficient disclosure can therefore arise with respect to either of these two disclosure requirements.

Therefore, the rejection over Claims 3-4, 10, and 16 retains.

Claim Objections

Claims 5-6, 11-12, and 17-18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claims. The composition claims 5-6 are duplicates of claim 4. Claims 4-6 claim the same composition, and intend to use bearing no weigh. Therefore Claims 5-6 should be cancelled.

For the same reason, claims 11-12, and 17-18 are objected. Applicants are required to cancel claims 11-12, and 17-18.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

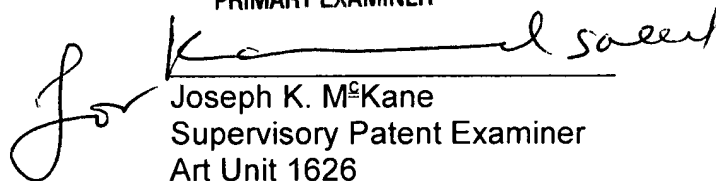
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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